

E. Remarks

Reconsideration and allowance in view of the amendments made and comments which follow are respectfully requested.

Claims 1-21 were pending. Claims 6, 7, 8, 9, 10, 11, 12, 13, 14, 15 and 21 are being amended, and new claims 22 and 23 are being added. Claims 1-23 are now pending.

In the Office Action the Examiner rejected claims 3, 6, 9, 12, 13 and 21 as allegedly anticipated by Octo-Square Brilliant in Mauer Lapidary Journal, March 1994 ("Octo-Square"), and claims 1, 2 and 15 as allegedly obvious over this reference. The Examiner also rejected claims 6-8, 10, 11, 13, 14, 17, 18 and 20 as being allegedly anticipated by Montana Burst in Graham Gram 1 Faceting Designs ("Montana Burst"), and claim 19 as allegedly obvious over this reference.

The Examiner indicated that claims 4-5 and 16 are allowed.

Applicant will first discuss the Octo-Square reference generally, and then discuss the distinctions between the claims against which it was cited and the reference.

As used in Octo-Square, the term "octagon" in step 11 is understood by those of skill in the art to mean a polygon with eight equal sides. The intention in Octo-Square is to achieve an eight equal sided table. If such were not the case, there would be no need to instruct workers in cutting step 11: "cut 4 star facets at 10 degrees approximately, the angle may have to be altered slightly to make the table an octagon 12, 36, 60, 84." (emphasis added) In other words, if a worker simply cut the 4 star facets cut 10 degrees, he would always achieve an 8-sided polygon with eight sides, but the 8-sided polygon would not necessarily result in an octagon, i.e., a table having 8 sides of equal length. Because the text instructions direct a worker to alter from 10 degrees as needed to make the table an octagon, the term "octagon" as used in this step 11 must mean eight equal sides. Otherwise, no alteration of the angles would be needed to obtain an eight sided polygon whose sides need not be equal.

Applicant believes that the drawings in this reference are provided for general guidance only and that the text instructions, which are quite detailed as to cutting angles and the like, should take precedence over the sketches in order to understand the designer's intention. Thus, even if the bottom sketch in Octo-Square could be interpreted as having corners slightly less than the sides, applicant believes that those of ordinary skill in the art would not look to the sketch for instructions on how to cut the stone but instead would look to the detailed textual instructions and refer to the sketches only for general guidance.

There is yet another reason why a gem stone cutter would interpret the Octo-Square reference as having a table of eight equal sides to form an octagon. The first two steps of each corner of the crown get smaller in width as the facet lines go up from the girdle toward the table. For the third step, the designer obviously wanted to depart from this trend and create a table with eight equal sides, rather than simply obtain a table with sides longer than and corners.

In any event, even if one skilled in the art could interpret Octo-Square to have a table with corners slightly less than the sides, applicant in certain of its pending claims recites that the corners are "substantially less" than the sides. The clear objective in Octo-Square is not to have its table corners "substantially less" than its table sides. The very reason why Octo-Square in its third step increases the length of the corners is not to have the corners substantially less than its sides. The effect that the Octo-Square designer was trying to achieve was an octagon table, not a table with corners substantially less than its sides. Thus, even if one skilled in the art would interpret Octo-Square to have table corners slightly less than its table sides, such person would not be motivated to modify Octo-Square to have table corners substantially less than the table sides.

Last but not least, the name for this stone, "Octo-Square Brilliant", indicates that the table was intended to be eight sided polygon with equal sides. The girdle is actually an eight sided polygon, but the term "square" in the name is understood to refer to the main shape of the stone at the girdle, which is a cut-cornered square. Even though the girdle actually has eight "sides", the designer calls it a square and not an "octagon". The designer uses the term "octo" to refer to the table to distinguish it from the predominantly square girdle. By using both "octo" and

“square”, the designer wanted to create a distinction between the “square” girdle and the “octo” table with its eight equal sides.

For at least these reasons, claims 1 and 15 are not anticipated by or obvious over the Octo-Square reference. With regard to claim 2, claim 2 depends on claim 1, and should be patentable for at least the same reasons that claim 1 is patentable.

Applicant respectfully traverses the rejection of claim 3 based on Octo-Square Brilliant. Any attempt to read claim 3 on Octo-Square Brilliant will result in not all of the rib lines extending in a substantially straight line when viewed from the bottom of the culet and still have the rib lines define a corner having a plurality of facets. If one were to define the rib lines so that each corner has a plurality of facets as required by the claim, the rib lines, instead of following a substantially straight line, would take a turn of about 45 degrees as the “line” travels from the girdle to the culet. A turn of 45 degrees would not be a “substantially straight line”. Applicant points out that the term “substantially straight line” as used herein need not be in a perfectly straight line, as one of ordinary skill in the art may decide to make some minor bends or make minor angular changes in the line, and still have the line be a substantially straight line according to the invention defined by this claim. Claim 3 is believed to be patentably distinct over Octo-Square Brilliant for at least the reason discussed.

With regard to claim 6, without conceding the correctness of the Examiner’s position, but solely to advance prosecution, claim 6 has been amended to recite that the table is flat, and that the table has corners which are substantially less in length than the table corners. In Octo-Square, the table is not flat if it includes the corner and side facets as proposed by the Examiner, and the single table facet at the top does not have corners substantially less in length than its corners as discussed above in connection with claim 1.

With respect to the rejection of claim 1 based on Montana Burst, Montana Bust does not have a table with any corners less than, much less substantially less than, the length of table sides.

With regard to claim 7, without conceding the correctness of the Examiner's position, but solely to advance prosecution, applicant has amended claim 7 to recite that the table corners are substantially less in length than the table sides, which feature is not shown in Montana Burst. To the same effect are claims 8, 10, 11, 13 and 14 (and dependent claims 17, 18, 19 and 20).

With regard to claim 9, without conceding the correctness of the Examiner position but solely to advance prosecution, applicant has amended claim 9 to recite that the table is flat, and not merely substantially flat; and wherein all of the steps in each crown side have the same facet corner angles. Although the claim recites two steps as a minimum, the feature that all of the steps in each crown side have the same facet corner angle applies to all of the steps, however many steps are present. In Octo-Square, there are three steps in each side in the crown (aside from the flat table), and the upper most step does not have the same facet corner angle as the first and second step, so this reference does not anticipate this claim.

With regard to claim 12, without conceding the correctness of the Examiner's position 1 but solely to advance prosecution, applicant has amended claim 12 to recite that substantially straight distinct rib lines define four corners (as well as four sides), and wherein each pavilion corner has a plurality of facets. In the Octo-Square reference, in order for the pavilion corners to have a plurality of facets, the rib lines would not be substantially straight, but would have a turn of about 45 degrees. As used in this claim the term "substantially straight" does not require that the lines be totally straight, as they may have minor bends as discussed above.

With respect to the rejection of claim 13 based on Octo-Square, without conceding the correctness of the Examiner's position, but solely to advance prosecution, claim 13 has been amended to recite that the rib lines define four corners, with each corner having a plurality of facets, and wherein the intersection point in each pavilion side is not on the rib line. This claim distinguishes over Octo-Square. If one were to define rib lines in Octo-Square such that the corners have a plurality of facets, then the plurality of facets in each pavilion side do not have their intersection point away from the rib line. The only way for the pavilion sides in Octo-square to have all of their facets intersect at a common intersection point not on a rib line would result in the facet corners having only one facet, which arrangement does not anticipate claim 13.

With respect to claim 21, without conceding the correctness of the Examiner's position, but solely to advance prosecution, claim 21 has been amended to recite that the table is flat. The Octo-Square reference does not disclose amended claim 21. In this reference, its table, to be flat, must be devoid of steps, and then the crown steps must include the upper most step. However, the claim requires that all of the steps in the crown sides (not just the minimum of two steps) are defined by straight lines from the girdle to the table, which is not disclosed in Octo-Square Brilliant.

New claims 22 and 23 are being added. These claims are based on claim 13 (prior to current amendments to claim 13), and recite additional features. Claim 22 recites that the pavilion side facet which has a facet corner at the culet has four sides, and thus distinguishes patentably over Octo-Square. This claim also distinguishes over Montana Burst because it recites that the table corners are substantially less than the table sides.

Claim 23 recites that the rib lines are substantially straight and the pavilion corners have a plurality of facets, distinguishing over Octo-Square Brilliant, and recite that the table corners are substantially less than the table sides, distinguishing over Montana Burst.

In view of the foregoing, applicant believes that the application is in condition for allowance, and such action is earnestly solicited.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

Tiffany & Company
Reissue Application No.: 10/626,376
Reissue of Patent No.: 6,363,745
Page 18

Other than the additional claims fees, no additional fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



Peter J. Phillips
Registration No. 29,691
Attorney for Applicant
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

 1/14/05
Peter J. Phillips Date
Reg. No. 29,691

Tiffany & Company
Reissue Application No.: 10/626,376
Reissue of Patent No.: 6,363,745
Page 12

D. Amendment to drawing figures

No amendments to the drawing Figures are proposed.